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10/826,651	04/16/2004	Richard J. Morris	1915.24US04	2287

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EXAMINER

LU, JIPING

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3749

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/826,651
Filing Date: April 16, 2004
Appellant(s): MORRIS ET AL.

MAILED

AUG 01 2006

Group 3700

Wm. Larry Alexander
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/25/2006 appealing from the Office action mailed 7/25/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

WO 99/35446	Morris et al.	7-1999
6,298,613	Coulton et al.	10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morris (WO 99/35446) in view of Coulton et al. (U. S. Pat. 6,298,613).

The roof ridge vent of Morris is identical to the present claims. Morris does not show a filter material secured to the bottom surface of the vent part. Patents to Coulton et al teach a roof ridge vent with filter 50 secured to the bottom surface of the vent part same as claimed. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide Morris (Fig. 15) with the filter of Coulton. in order to improve the ventilation efficiency.

(10) Response to Argument

A. Legal Background

On pages 6-8, Paragraph VII, A, the appellant has set forth the burden of proof, Prima Facie case of obviousness and motivation to combine prior art references in the legal background. This is acknowledged by the examiner. No rebuttal is deemed necessary.

In order to crystallize the issue, a comparison of the alleged invention and the prior art references is deemed to be necessary. The primary reference, Morris (WO 99/35446), shows an overall combination to be identical to the broad independent claims 1, 13, 14, 15, 16 and 26

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except the extra piece of a conventional air permeable filter material 34 (see Figs. 6 and 7 of current application). Fig. 1 of Morris (WO 99/35446) is also identical to the Fig. 1 of the current application except for the filtering material 34 in current application. The patent to Coulton et al. (U. S. Pat. 6,298,613) shows (Fig. 2) a roof ridge vent 30 with filter 50 secured to the bottom surface of the vent part 30 same as claimed. Fig. 2 of Coulton patent is similar to the Fig. 7 of the current application. The only issue under this appeal is whether or not it is obvious for one skilled in the art to provide Morris (Fig. 15) with the air permeable filter 50 of Coulton in view of the combined teachings of the prior art references. The answer is affirmative, see rejection *supra*.

B. Analysis

On pages 8- 9, Paragraph VII, B, the appellant argued that none of the references disclose the limitation regarding “to the bottom surface of the at least one vent part and to the top panel” as call for in broad claim 1. This is not true. The secondary reference, Coulton et al US Pat. 6298613 clearly shows that the air permeable filter 50 is located and installed to the bottom surface (at 42) of the at least one vent part 30 and to the top panel 62 (at 52, 54). The appellant also argued that none of the references disclose the limitation regarding “to the bottom surface of the top panel and positioned to filter air being conveyed through the top panel air passages or the vent air part air passage” as called for in broad claim 13. This is not true. The secondary reference, Coulton et al US Pat. 6298613, clearly shows that the air permeable filter 50 is located and installed to the bottom surface (at 52, 54) of the top panel 62 and positioned to filter air being conveyed through the vent air part air passage (see arrows in Fig. 2). The appellant also argued that none of the references disclose the limitation regarding extending the claimed

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filtering material “between the top panel and the bottom surface of one of the vent parts” as called for in broad claim 14. This is not true. The secondary reference, Coulton et al US Pat. 6298613, clearly shows that the air permeable filter 50 is located and installed between the top panel 62 and the bottom surface of one of the vent parts 32 (at 52, 54). The appellant also argued that none of the references disclose the limitation regarding “allowing air exchange between the structure interior and the environment via the top panel passages, the vent part air passages, and the filter material” as called for in broad claim 15. This is not true. The primary reference, Morris publication, clearly shows (Fig. 1 identical to the applicant’s Fig.1) that air exchange features between the structure interior and the environment via the top panel passages 144 and the vent part air passages 144 (page 13, lines 5-15). The secondary reference, Coulton et al US Pat. 629861, clearly shows that the air exchange feature (see arrows in Fig. 2) between the structure interior and the environment via the vent part air passages and the filter material (see Fig. 2). The air will penetrate through the permeable filter 50 and exit through 56. The make up or exchanged air will come into the structure interior due to natural phenomenon (e.g. natural air convection). Therefore, in view of the combined teachings of Morris and Coulton, the roof venting method of Morris as modified by Coulton clearly shows the method of allowing air exchange between the structure interior and the environment via the top panel passages, the vent part air passages, and the filter material. The appellant also argued that none of the references disclose the limitation regarding “securing an air permeable filter material to an interior surface of the top panel and to the vent part” as called for in broad claim 16. This is not true. The secondary reference, Coulton et al US Pat. 6298613, clearly shows that the air permeable filter 50 is secured to an interior surface (at 52, 54) of the top panel 62 and to the vent part (at 42). The

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appellant also argued that none of the references disclose the limitation regarding “the filter material secured to the bottom surface of the vent part and to the top panel” as called for in broad claim 26. This is not true. The secondary reference, Coulton et al US Pat. 6298613, clearly shows that the air permeable filter 50 is secured the bottom surface (at 42) of the vent part 32 and to the top panel 62 (at 52, 54). These claimed various locations of the filter material in the independent claims are clearly shown by the prior art reference to Coulton et al. Therefore, a prima facie evidence of obviousness is established by Coulton patent. In view of the combined teachings of the Morris and Coulton, it would have been obvious for one skilled in the art to provide Morris (Fig. 15) with the conventional air permeable filter 50 of Coulton.

On pages 9-12, Paragraph VII, B, 3a-3b, the appellant argued that the rejection does not cite supporting portions of the prior art when asserting the required motivation and the combination or modification of prior art references must come from the prior art references themselves. Therefore, the rejection to combine Morris and Coulton is improper. The appellant also argued that the examiner’s motivation regarding ventilation efficiency incorrect and therefore the rejection to combine Morris and Coulton is improper. The examiner disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found **either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.** See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Therefore, the motivation does not have to come from the prior art references themselves. The motivation may come from anywhere, e.g. common sense, combined teachings

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of the prior art references. In this case, it is the combined teachings of Morris and Coulton that would lead one skilled in the art to provide Morris (Fig. 15) with the air permeable filter 50 of Coulton in order to improve ventilation efficiency. It should be noted in the ventilation art, the use of air permeable filter is common practice. The air permeable filter will provide air ventilation and also prevents rain, snow, insects from entering into structure interior. Thus air ventilation will be improved. In the present case, the teaching to combine came from Coulton. Coulton expressly teaches to provide or use of a conventional air permeable filter to prevent insects, snow, rains from clogging the air passage (col. 4, line 57 to Col. 5, line 11). Therefore, the air ventilation efficiency can be improved. Another example, it is also well known in the art to provide screen chimney cap in most residential homes. The purpose for the screen chimney cap is to prevent birds, snow from clogging the chimney in order to maintain the exhaust gas flow (i.e. improve ventilation efficiency). The use of screen or permeable air filter to maintain air/gas flow is a common practice and well known in the art. Therefore, it is not appropriate and unnecessary for the examiner to provide any affidavits as requested by the appellant.

On page 12, Paragraph VII, B, 3c, the appellant argued that in the present application teaches away from the proposed modification, e.g. improve ventilation. Therefore, the rejection to combine Morris and Coulton is improper. In particular, the appellant argued that the claimed conventional filtering fabric 34 allows 75% of air passing or flowing (see footnotes 69, 70 of page 12 the Brief). Therefore, the 75% airflow or pass does not improve the ventilation. Thus, the teaching from the references is not valid, e.g. teach away. The examiner disagrees with the appellant's line of reasoning. As usual in any technology, that any improvement will incur a cost. In the present case, the improvement, alleged invention, is to use a conventional air

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permeable filter within an air passage. The prior art clearly shows this use of air permeable filter for prevention of insects, snow or rains in order to avoid clogging or improve ventilation. At the same time, as correctly pointed out by the appellant, the air permeable filter will reduce airflow due to the resistance. This is the cost to pay for the prevention of clogging in order to improve ventilation. The fact that applicant has recognized another advantage to place air filter within passage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In the rejection, the motivation is to improve ventilation efficiency. This is a common practice and well known in the art because the screen or permeable filter will prevent insects from trapping or clogging inside the air passages. Thus air ventilation efficiency can be improved. The motivation to combine could come from anywhere, e.g. prior art reference itself, common sense, common knowledge, combined teachings of prior art, etc. The stated motivation in the rejection, supra, is merely an example. There are other motivations also (see lines 57-67, col. 4 of Coulton). It cannot be said the present claimed conventional features teach away from the proposed modification. Moreover, the arguments sated in the footnotes 69, 70 of page 12 the Brief, are not germane to the claims at issue because no such limitation is found in the claims 1, 13-16, 26.

On page 13, Paragraph VII, B, 3c, the appellant argued that in the presence of a claim limitation in the prior art reference per se is not the required motivation. Therefore, the rejection to combine Morris and Coulton is improper. The examiner disagrees. It is the examiner's position that the mere presence of a claim limitation in the prior art reference per se is sufficient to show the claimed features are well known and conventional. It would inevitably lead to

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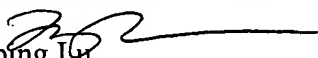
motivate one skilled in the art to improve and invent. The examiner simply cannot agree with the appellant's arguments.



(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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Art Unit 3749

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